

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks and accompanying information, which place the application in condition for allowance.

1. Status Of Claims And Formal Matters

Claims 1-15, 17, 22-29 and 44-46 were under consideration in this application. Claims 30-43 have been canceled, claims 1-6, 9-11, and 26 have been amended, and new claim 47 has been added. Support for the claim amendments is found throughout the specification as originally filed. No new matter has been added by this amendment.

The Examiner is thanked for indicating that claims 26 and 27 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

2. The Rejections Under 35 U.S.C. § 112, Second Paragraph, Are Overcome

Claims 3-8, 11 and 25 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner alleges that “compensating volume” is unclear in claims 5 and 6 and that “supplementary volume” is unclear in claim 11. This rejection is respectfully traversed and it is respectfully pointed to the fact that in the claims 5 and 6 the compensatory or supplementary volume has originally been defined as “part of a diluent”. As actually the diluent introduced in the claims 1 or 2 is meant, the claims 5 and 6 now are amended to recite “**the**” diluent, of which the compensation or supplementary volume actually is a part. Claim 11 has been amended accordingly. Support for this amendment is found e.g., on page 11 (lines 28-30) and on page 13 (lines 17-19) of the application as originally filed. This rejection is moot in light of the amendments to the claims submitted herein. Specifically, the claims have

been clarified to recite a compensating or supplementary volume as being a part of the diluent, thereby obviating the rejection.

It is believed that the rejections under 35 U.S.C. § 112, second paragraph, have been overcome. Reconsideration and withdrawal are requested.

3. The Rejections Under 35 U.S.C. §103 Are Overcome

Claims 1-15, 17, 22-25, 28, 29 and 44-46 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,061,639 to Lung *et al.* (hereinafter "Lung") in view of U.S. Patent No. 5,320,969 to Bauer *et al.* (hereinafter "Bauer"). These rejections are respectfully traversed. The cited references do not make the instant invention obvious.

The Examiner is respectfully directed to the case law, namely, that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Further, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." For the §103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed.Cir. 1988).

Applying the law to the instant facts, the reference relied upon by the Office Action does not disclose, suggest or enable Applicants' invention.

Accompanying this response is a true copy of a Declaration Under 37 C.F.R. § 1.132 by Dr. Werner J. Hälg (hereinafter "Hälg Declaration"). The Hälg Declaration summarizes the present invention as well as the inventions of Bauer and Lung. The examiner contends that "it would be obvious to substitute the colorimetric reagent of Lung for the polyvalent metal-ion complex of Bauer to provide a reagent resulting in enhanced color transition." As the Hälg Declaration clearly points out, Bauer bears no resemblance to the present invention as it is used for specific gravity determinations rather than volume determinations. Moreover, the method of measurement between Bauer and the present invention clearly differs in that the former relies on ion displacement and the later relies on colorimetric measurements. The examiner correctly points out that some of the same colorimetric reagents used in the present invention are

mentioned in Bauer. However, as stated in the Hälgl Declaration, "Bauer cites every known indicator that binds to a polyvalent ion as examples of potential colorimetric reagents." There is no indication that the dyes used in the present invention offer any advantage over the numerous other examples provided. Hence, one looking to develop a method of accurately measuring very small volumes certainly would not look to Bauer for motivation.

In Lung, a method to accurately determine the volume of a liquid dispensing device is described. The Hälgl Declaration plainly shows the large distinction between the present invention and Lung. Lung relies on having two wells for each volume to be determined and volume determinations are made by comparing the absorbance of a 'test' well using a reference pipette and a second well containing the liquid to be measured. Importantly, the colorimetric reagent is pipetted directly into the wells. The present invention is considerably different as it does not make use of a two well system. As pointed out by Dr. Hälgl, such a two well system adds another source of error to making volume determinations and it may only be amenable with rather sophisticated mechanical equipment, as described in Lung. Instead, in the present invention, only one well is needed for each volume determination and the measured absorbance is compared to a standard Beer's law plot.

Lung does not contemplate the essential advantage of the present invention, namely the ability to measure exceedingly small volumes accurately. The Hälgl Declaration unmistakably points out that a key feature of the present invention is generating the dye *in situ*, a factor which abolishes many of the problems which have hampered accurate measurements of very small volumes in the past. Lung does not consider measuring small volumes by forming dyes *in situ*. In fact, the method of Lung necessitates pipetting the colorimetric reagent directly into the wells and thus, problems associated with measuring small liquid volumes can not be overcome by applying Lung.

The specification of Lung gives no motivation to combine with Bauer. However, as pointed out clearly in the Hälgl Declaration, "even if one were to undertake the laborious task of going through the thousands of possible polyvalent/ligand combinations in Bauer" to find the ones claimed in the present invention, applying that colorimetric reagent to Lung would still be clearly distinct from the present invention. Hence, the present invention is novel over the cited prior art.

Consequently, reconsideration and withdrawal of the Section 103 rejections are earnestly requested.

REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance, a further interview with the Examiner and SPE are respectfully requested and the Examiner is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

CONCLUSION

In view of the remarks, amendments and Hälg Declaration, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

Respectfully submitted,
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